

REMARKS

Claims 1-5 stand rejected under 35 U.S.C. §102(b) as being unpatentable over the disclosure in U.S. Patent 6,106,020 of Leef, *et al.* ("Leef, *et al.*"). The Examiner stated that Leef, *et al.* disclosed a method for providing personal identification on checks issued by a payor to payees which was applicable to Claim 1 of the present application, the method of Leef, *et al.* including the steps of:

(a) obtaining a digital image of each payee, as allegedly shown in FIGS. 1 and 2;

(b) assigning a unique filename to each said digital image which is allegedly uniquely associated with each payee, as allegedly forth in Col. 3, lines 30-41 and Col. 4, lines 61-67;

(c) storing each digital image on a computer storage medium using each said unique filename, as allegedly forth in Col. 3, lines 30-41 and Col. 4, lines 61-67;

(d) selecting payee data for check printing, said data including, for each payee, said unique filename, as allegedly forth in Col. 3, lines 54-65;

(e) printing checks for said payee data for each check, each said check being printed with an image of the payee retrieved from said computer storage medium using said unique filename, as allegedly forth in Col. 3, lines 29-65

whereby each check will include, in addition to the other information, a photographic image of the payee to whom such check was written, as allegedly shown in FIGS. 1 and 2 and Col. 3, lines 29-65.

The Examiner further stated that with respect to Claim 2 of the present invention, Leef, *et al.* disclosed the method for providing personal identification on checks issued by a payor to payees as set forth with respect to Claim 1 wherein the step of obtaining a digital image is accomplished by taking a photograph using a digital camera, as allegedly set forth in FIG. 1(2), Col. 2, lines 37-54.

The Examiner further stated that with respect to Claim 3 of the present invention, Leef, *et al.* disclosed the method for providing personal identification on checks issued by a payor to payees as set forth with respect to Claim 1 wherein the step of obtaining a digital image is accomplished by taking a photograph using a digital camera, as allegedly set forth in Claims 1 and 11.

The Examiner further stated that with respect to Claim 4 of the present invention, Leef, *et al.* disclosed the method for providing personal identification on checks issued by a payor to payees as set forth with respect to Claim 1 wherein the step of assigning a unique filename is accomplished by assigning a name uniquely associated with each said payee, such name being selected from the group consisting of the payee's social security number, the payee's employee identification number, and the key field in the database containing the payee's data, as allegedly set forth in FIG. 1(2), Col. 2, lines 37-54.

The Examiner further stated that with respect to Claim 5 of the present invention, Leef, *et al.* disclosed the method for providing for providing personal identification on checks issued by a payor to payees as set forth with respect to Claim 1 wherein the step of selecting payee data for check printing is accomplished by using data

from each payee's data record to generate a filename which is uniquely associated with each said payee's image file, as allegedly set forth in Col. 3, lines 29-56.

As each of Claims 1-5 stand rejected solely under 35 USC §102(b) the only question which must be resolved is whether the claims of the present application read on the disclosure of Leef, *et al.*

Prior to addressing the issues raised by the Examiner, Applicant believes that it would be helpful to point out a number of differences between the present invention and the invention described by Leef, *et al.*, as it appears that the Examiner has confused a number of issues. First, the intent of the present invention is to imprint checks with the likeness of the account holder, whereas in Leef, *et al.* the intent is to imprint the image of the person who negotiates the check. The person who negotiates a check (pursuant to the Uniform Commercial Code) is the one, against whom, the recipient of the check (i.e., the party to whom the check is given or negotiated) has a primary claim should the check ultimately be dishonored, irrespective of who issued the check. After a check has been issued, it becomes a "negotiable instrument", and any further holder of the check can either deposit it, or enter an endorsement on it, and further negotiate it to some other party. By way of example, a government check could be perfectly good, but it can be stolen from the rightful owner (e.g., the not uncommon act of stealing social security checks from the mailboxes of their recipients). In accordance with the teachings of the present invention, the check would have on it the photo of the intended recipient, but not the photograph of any further holder, whereas in accordance with the invention of Leef, *et al.* the check would not have any photo thereon until such time as it was negotiated by the person seeking to "cash" or deposit it. Thus, in accordance with the

present invention, the rightful payee's photo would be on the check, and when the check was presented for deposit, the intended recipient could compare that photo with the payee, to determine whether the named payee appeared to be the person presenting the check. In the case of the stolen social security check, the person presenting the check is not likely to look like the proper payee, so the check will not be accepted in the first instance.

In accordance with the invention of Leef, *et al.*, on the other hand, a photo of the person presenting the check is taken, so that in the event that the check is dishonored, and returned to the party who accepted it, the party who accepted the (dishonored) check will have a photograph of the person who presented it to them. In the case of the stolen social security check, the party who had accepted the dishonored check would be out the money, unless and until they apprehended the person who presented it, and were then able to recover the amount of their loss from that person.

Thus, the invention of Leef, *et al.* acts like a security camera in a store, in that it is helpful *after the fact* to apprehend and prosecute the person who "passed" a bad check (See, Leef, *et al.* Col. 4, lines 8-14). The present invention, on the other hand, acts like a built-in "ID" to confirm that the person presenting the check, in the first instance, is the person to whom the check was issued.

Leef, *et al.* also presented an alternative embodiment of their invention in which the photograph of a new checking account holder is printed on a set of "starter checks", so as to make them more acceptable to businesses which are often unwilling to accept such starter checks (e.g., the checks which have only an account number preprinted on them, which are generally devoid of the name and address of the account

holder or preprinted check numbers). As the person who opens a checking account is the payor (e.g., the person who issues checks), rather than a payee, it is clear that the present invention is unrelated to that aspect of the teachings of Leef, *et al.*

Referring now to the Examiner's action, and the claims of the present invention, Claim 1 relates to the method of having a payor print unique photos of the individual payees on checks which the payor is issuing to payees. While the Examiner indicated that Claim 1 was not patentable over the disclosure of Leef, *et al.*, it is apparent that the Examiner did not observe the inherent differences between the present invention and the invention described by Leef, *et al.* In particular, step (a) of Claim 1 of the present application requires that the payor obtain a digital image of each payee. The Examiner contended that step (a) of Claim 1 was met by FIGS. 1 and 2 of Leef, *et al.* In fact, FIGS. 1 and 2 of Leef, *et al.* illustrate the use of a digital camera 2 to take the photograph (See, FIG. 2) of the individual "who has possession of the document" (*i.e.*, the check), at the time the check is presented (See, the Abstract and Col. 3, line 66 through Col. 4, line of Leef, *et al.*). While there will be instances in which a check is issued to a payee who then presents the check, and is first photographed at the time of presentment (See, Leef, *et al.*, Col. 4, lines 24-30), it is clear that the image which is ultimately printed on the check did not come from a digital image obtained by the payor, assigned a unique file name by the payor, and stored on a computer system of said payor, as set forth in Claim 1, which has been amended to clarify that point. It is also clear that the payee data which is printed on the check differs from anything described by Leef, *et al.*, in that Leef, *et al.* were concerned with the image of the person possessing the check, who might well be a different person from the person who was the named payee.

With continued reference to the Examiner's references, and given the understanding of the differences between the present invention, and the teachings contained in Leef, *et al.*, it is quite clear that the assignment of a unique filename by the payor (Step (b)), while present in the invention, has nothing to do with the teachings of Leef, *et al.* Leef, *et al.* disclosed two embodiments. In the first embodiment, a photo of the person presenting the check is taken, and printed on the check, at the location where the check is presented, not where it is initially printed. The photo is of the person presenting the check, who is not necessarily the payee of the check. In accordance with that embodiment, the digital file used by the camera to store the photo while it is being printed, may be overwritten immediately thereafter to save space on the computer system. In fact, there is no need or reason to retain the digital image once it has been taken and printed on the check. Accordingly, there is no need nor reason (nor any teaching in Leef, *et al.*) to retain the image as a digital file on the computer. As only one photo is being taken at a time, and as it is then printed on the check (*See*, Col. 3, line 66 – Col. 4, line 7), the very next photo can be assigned the same filename, and the original file can be overwritten.

In the second embodiment described by Leef, *et al.*, it is more likely that a unique filename would be assigned, however there is no teaching to that effect. Besides, in the second embodiment, the photo which is printed on the "starter" checks is not a photo of the payee, but a photo of the account holder.

In view of the foregoing explanation, it is clear that steps (b) and (c) of Claim 1 differ from the methods described and taught by Leef, *et al.*

Regarding, step (d) of Claim 1, there is no teaching in Leef, *et al.* to print checks with unique *payee* information. The closest which Leef, *et al.* come to teaching the printing of checks with unique information, relates solely to their teaching with respect to *payor* information on "starter" checks.

It further follows that Leef, *et al.* taught nothing of step (c), which involves the printing of checks with *payee* data by the *payor*.

In view of the foregoing comments, it is clear that Claim 1 does not read on anything contained in Leef, *et al.* To the contrary, Claim 1 teaches a totally different approach than that taught by Leef, *et al.* Whereas Leef, *et al.* are concerned with discouraging check fraud by printing the photo of the person possessing the check (Col 4, lines 8-14) and/or identifying the account holder of "starter" checks (Col. 3, lines 46-64), the present invention seeks to prevent such fraud by having the checks, from the time they are initially printed, act to identify the payee. It is noteworthy in that regard that the taking and printing of the photos in the invention of Leef, *et al.*, is done by either the party receiving the check, or by the bank (for "starter" checks), while it is done by, or for, the payor in accordance with the present invention.

In view of the above remarks, applicant respectfully contends that Claim 1, which has been amended solely to clarify the issues set forth above, does not read on anything described by Leef, *et al.* Thus, the rejection of Claim 1 based on 35 U.S.C. §102(b) is improper and should be withdrawn. While the rejection of Claim 1 was based solely on, and is improper under, 35 U.S.C. §102(b), it is also clear that due to the differences noted above, that any potential rejection of Claim 1 which employs the teachings of Leef, *et al.* under 35 U.S.C. §103, would be improper, as the teachings in

Leef, *et al.* have nothing to do with a payee retaining digital photographs of its payees and then printing those photos on the checks which it issues to those payees. Further, while Leef, *et al.* would require a party who receives a check, or a bank which prints "starter" checks, to have a digital camera, computer system, and printer, the present invention imposes no such requirements on either the bank or the recipient of a check.

Claim 2 of the present invention depends from Claim 1, and it is more limited in scope than Claim 1. Accordingly, for the reasons set forth above, Claim 2 does not read on anything disclosed by Leef, *et al.* Further, for the reasons expressed above, any potential rejection of Claim 2 under 35 U.S.C. §103 would be improper due to the lack of teachings in Leef, *et al.*, as set forth above.

With respect to Claim 3, it is important to note the objective of the present invention, which is to have a payor be able to imprint images of its payees on checks which it issues. Thus, there may be instances in which payees are remote from the payor. The issuance of social security checks by the government would be one such example. In such instances, it might be difficult for the payor to have each payee sit for a photo, and it might be significantly easier to have the payor simply scan a photo provided to it by the payee. Nothing in Leef, *et al.* is in any way related to Claim 3 of the present invention. Accordingly, for the reasons set forth above, Claim 3 does not read on anything disclosed by Leef, *et al.* Further, for the reasons expressed above, any potential rejection of Claim 3 under 35 U.S.C. §103 would be improper due to the lack of teachings in Leef, *et al.*, as set forth above.

Claim 4, is dependent from Claim 1, and it is more limited in scope than Claim 1. For the reasons set forth above, with respect to Claim 1, Claim 4 does not read

on anything contained in Leef, *et al.* Further, it is clear that the teachings contained in Leef, *et al.* could not be combined with other teachings to form any potential rejection of Claim 4 under 35 U.S.C. §103 for the reasons expressed above. Notably, the "personal information" to which the Examiner made reference in Leef, *et al.* (*i.e.*, Col. 3, lines 54-60) relates to information imprinted by a bank, on "starter" checks. It has nothing to do with the creation of unique filenames for storage of digital images on a computer system, by a payor.

Claim 5 is similar to Claim 4, and is patentable for the same reasons. Nothing in Leef, *et al.* relates to the creation of unique filenames for storage of digital images on a computer system, by a payor.

In view of the foregoing remarks, it is abundantly clear that the sole rejection, pursuant to 35 U.S.C. §102(b), of Claims 1-5 is inappropriate. As set forth above, Claim 1 has been amended solely to clarify and highlight the distinction that the present invention relates to obtaining digital images of payees by a payor, who imprints those images on checks at the time they are printed, whereas Leef, *et al.* are concerned with imprinting images of an account holder, by a bank, for "starter" checks; or, alternatively, by a potential recipient of a check. These are totally different inventions, which serve totally different purposes, as set above. Accordingly, applicant respectfully requests that the Examiner reconsider the applicant's invention in light of the above remarks, and the teachings of Leef, *et al.* and that he now allow the application.

Attorney Docket No. 170802-1010

Marked-Up Version of Replacement Paragraph(s)/Section(s)**Claim Amendments:**

1. (Amended) A method for providing personal identification on checks issued by a payor to payees which includes the steps of:
 - (a) the payor obtaining a digital image of each payee;
 - (b) said payor assigning a unique filename to each said digital image
 - 5 which is uniquely associated with each payee;
 - (c) storing each said digital image on a computer storage medium of said payor, said images each being stored by said payor using each said unique filename;
 - (d) selecting payee data for check printing, said data including, for each
 - 10 payee, said unique filename;
 - (e) printing checks for said payee data for each check, each said check being printed with an image of the payee retrieved from said computer storage medium using said unique filename,
 - whereby each check will include, in addition to the other information, a
 - 15 photographic image of the payee to whom such check was written.

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2. (As filed) The method for providing personal identification on checks issued by a payor to payees of Claim 1 wherein the step of obtaining a digital image is accomplished by taking a photograph using a digital camera.
3. (As filed) The method for providing personal identification on checks issued by a payor to payees of Claim 1 wherein the step of obtaining a digital image is accomplished by scanning a conventional photograph.
4. (As filed) The method for providing personal identification on checks issued by a payor to payees of Claim 1 wherein the step of assigning a unique filename is accomplished by using assigning a name uniquely associated with each said payee, such name being selected from the group consisting of the payee's social security number, the payee's employee identification number, and the key field in the database containing the payee's data.
5. (As filed) The method for providing personal identification on checks issued by a payor to payees of Claim 1 wherein the step of selecting payee data for check printing is accomplished by using data from each payee's data record to generate a filename which is uniquely associated with each said payee's image file.